Office-Supreme Court, U.S.
FILED
JUL 5 1963
JOHN F. DAVIS, CLERK

In the
Supreme Court of the United States

OCTOBER TERM 1963

No. 255

BROS INCORPORATED

Petitioner

vs.

BROWNING MANUFACTURING COMPANY AND SHOVEL SUPPLY CO., INC.

Respondents

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE EIGHTH CIRCUIT

ANDREW E. CARLSEN
417 Plymouth Building
Minneapolis 2, Minnesota
Attorney for Petitioner

Of Counsel:
DOUGLAS L. CARLSEN

Hayward-Court Brief Ptg. Co., Mpls. 15, Minn.

INDEX

	PAGE
Petition for writ of certiorari	1
Opinions below	1
Grounds for invoking the jurisdiction of this court	5
Questions presented	6
Statutes involved	7
Statement of the case	7
Reasons for granting the petition for writ of certiorari	11
Conclusion	18
Certificate of Service	20
Appendix	A-1

AUTHORITIES CITED

Application of Pappas, 214 F. 2d 172	14
Bros Incorporated v. Tampo Manufacturing Company, No. 2860	4
Collins v. Owens, 310 F. 2d 884	15
Elizabeth v. Pavement Co., 97 U.S. 126, 24 L.Ed. 1000	16
Ex parte Public National Bank of New York, 278 U.S. 101, 49 S.Ct. 43	16
Hubbell v. United States, 179 U.S. 77, 21 S.Ct. 24, 45 L.Ed. 95	13
Lynch v. Alworth-Stevens Co., 294 F. 190	13
Mackenzie v. Hare, 239 U.S. 299, 36 S.Ct. 106	13
Trico Products Corp. v. Delman, 180 F. 2d 529	14
Warner v. Dworsky, 194 F. 2d 277	13
Washington Market Co. v. Hoffman, 101 U.S. 112, 25 L.Ed. 782	16
White v. Dunbar, 119 U.S. 530, 7 S.Ct. 376, 1886	11

In the
Supreme Court of the United States

OCTOBER TERM 1963

NO. ——

BROS INCORPORATED

Petitioner

VS.

BROWNING MANUFACTURING COMPANY AND SHOVEL SUPPLY CO., INC.

Respondents

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE EIGHTH CIRCUIT

Petitioner prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Eighth Circuit in the above-entitled case.

OPINIONS BELOW

The opinion of the Court of Appeals for the Eighth Circuit is reported at — F.2d —, and is reprinted in the Appendix hereto annexed (A-1).

The decision, by the United States District Court for the District of Minnesota, of February 21, 1962, as amended on May 9, 1962, with the Final Judgment of June 12,

1962, is reported only in 134 USPQ 231, but copies thereof are reprinted at pages 21, 49, 52, respectively, of the printed Record (R.) in the Court of Appeals.

The Minnesota District Court's Findings of Fact and Conclusions of Law, dated March 20, 1962, are reprinted at R. 35-44, and a Court Order of May 9, 1962, substituting a new Finding No. 21 and adding a new Finding No. 23, is reprinted at R. 49-52.

An Order, dated August 16, 1960, denying a plaintiff's Motion for Summary Judgment, and including an Opinion by the Minnesota District Court, is reported only at 126 USPQ 499, but is reprinted at R. 8-21.

The Bros patent No. 2,610,557 (R. 165-173), here in suit, was the subject of an earlier action filed June 24, 1954 in the United States District Court for the Northern District of Ohio, Eastern Division, entitled Wm. Bros Boiler and Manufacturing Company (By change of name now Bros Incorporated) v. Gibson-Stewart Company, Inc. The District Court's decision holding the patent valid and unfringed is reported only at 116 USPQ 138. The judgment was affirmed by the Sixth Circuit Court of Appeals, in *Gibson-Stewart v. Wm. Bros, etc.*, at 264 F.2d 776 reprinted in the Appendix hereto (A-9) and a petition for writ of certiorari was denied by the Supreme Court at 360 U.S. 929, 79 S.Ct. 1448.

Another suit for infringement of the Bros patent No. 2,610,557, was filed December 26, 1957 in the United States District Court for the Northern District of Texas, Dallas Division, Bros Incorporated v. W. E. Grace Manufacturing Company and William E. Grace. Summary judgment in favor of plaintiff was entered by the District Court, Bros Inc. v. W. E. Grace et al., 158 F.Supp. 786, the court holding that the Graces, having defended the Ohio

suit, were bound by the judgment therein under the doctrine of *res judicata*. That judgment was affirmed by the Court of Appeals for the Fifth Circuit, in Bros Incorporated v. W. E. Grace Mfg. Co. et al., 261 F.2d 428.

In the Ohio suit, and following the denial of certiorari by the Supreme Court, the appellant Gibson-Stewart Company, Inc. successively filed with the Sixth Circuit Court of Appeals (a) motions to stay and modify its mandate, (b) a petition to recall and modify the mandate, and (c) a request for reconsideration denying such petition. Such motions, petition and request all sought relief from the original judgment for the reason, *inter alia*, that the Bros patent should be declared invalid because the invention thereof was allegedly disclosed in the Bros pamphlet entitled "50 TON COMPACTOR WITH OSCILLATING WHEELS" being the same identical pamphlet which appears herein (R. 163-164) as Defendants Exhibit D-4, and which was held by the Minnesota District Court to have been published in July 1948 so as to constitute a statutory bar to the validity of the patent under Section 102(b), Title 35 U.S.C.

The (a) motions, (b) petition, and (c) request referred to in the foregoing paragraph were all denied by the Sixth Circuit Court of Appeals' Orders of July 30, 1959, October 1, 1959 and November 13, 1959, reprinted at R. 199-202.

In the aforesaid Dallas suit the Grace defendants, on or about December 9, 1959, filed in the U. S. District Court a Petition For Leave To Reopen, contending, *inter alia*, that the Bros patent in suit should be declared invalid by reason of the alleged disclosure of the invention in the same identical Bros pamphlet here in evidence as Defendant's Exhibit D-4 (R. 163-164) more than one year prior to the filing date of the application for the patent in suit so as to alleged-

ly constitute a bar to its validity under Section 102(b), Title 35 U.S.C.

The Order of the Dallas case District Court, of February 2, 1960, denying the Graces' Petition For Leave To Reopen, is reprinted at A-16.

In the aforesaid Dallas suit, the Graces, on March 9, 1962, filed with the U. S. District Court a Motion by Defendants under Rule 59 FRCP again seeking a new trial and again asserting invalidity of the Bros patent by reason of the publication of the Bros pamphlet (Def. Exh. 4, R. 163-164), allegedly "contrary to the conditions prescribed by 35 U.S.C. 102(b)," and in this instance supporting the Motion by supplying the Court with a copy of the Minnesota District Court's decision of February 21, 1962 (R. 21-34) holding the patent invalid under 35 U.S.C. 102(b).

The opinion of the Dallas District Court, of April 6, 1962, and Order of April 17, 1962 denying the Graces' Motion under Rule 59 is reprinted at A-17.

The Graces, as of April 23, 1962, filed a Defendants' Notice of Appeal to the United States Court of Appeals for the Fifth Circuit from the District Court's Order of April 17, 1962 denying the Motion under Rule 59 for new trial, and since that appeal is currently under consideration by the Fifth Circuit Court its decision thereon is not yet available.

Another, or fourth suit involving the Bros patent No. 2,610,557 was filed July 25, 1960 in the United States District Court for the Western District of Texas, San Antonio Division, being Civil Action No. 2860, *'Bros Incorporated v. Tampo Manufacturing Company*. That case has not been tried, and as yet there are no decisions to report.

GROUNDS FOR INVOKING THE JURISDICTION OF THIS COURT

The judgment of the Court of Appeals for the Eighth Circuit was dated and entered as of May 27, 1963. No petition for rehearing was filed, and no order for an extension of time within which to petition for certiorari has been requested. A motion to stay mandate, pending this application for certiorari, was granted by the Court of Appeals pursuant to Rule 16 of that Court.

Jurisdiction of this Court is believed to be conferred on it, for purpose of reviewing the judgment in question, by virtue of the provision of the Act of June 25, 1948, c. 646, 62 Stat. 928, 28 U.S.C.A. 1254(1), and Sec. 2101(c).

The jurisdiction of this Court is invoked on the grounds: (1) that the Bros et al. patent No. 2,610,557, as to all of its claims, has been held valid by the Sixth Circuit Court of Appeals and has been held invalid by the Eighth Circuit Court of Appeals, thus creating a serious conflict between judgments that should be resolved by this Court, (2) that the Eighth Circuit Court of Appeals has interpreted Sections 102 and 103 of Title 35 U.S.C.A. (the 1952 Patent Act) in a manner inconsistent with the language of the Act itself, and in direct conflict with the conclusions reached by the Sixth Circuit Court of Appeals; thus giving rise to an important question that should be answered by this Court, (3) that the Eighth Circuit Court of Appeals has construed the four claims of the Bros patent in suit in a manner which conflicts with the interpretation given them in the Sixth Circuit decision and is also inconsistent with the clear meaning and scope of the claims as determined by the record of proceedings thereon in the Patent Office, thus giving rise to confusion that is of critical importance particularly to the industry and to other courts that may yet be called on to adjudicate the claims.

QUESTIONS PRESENTED

1. When construing a patent claim, for purpose of determining the substance and scope of an invention, may limitations in the claim, that were expressly included to distinguish it from other claims that were rejected and withdrawn in the Patent Office, be disregarded?

2. When the language of a statute is so clear as to leave no doubt as to its meaning, may it be modified or qualified by reference to its legislative history?

3. Are the conditions for patentability of an invention, as set forth in Section 102 of Title 35 U.S. Code (the 1952 Patent Act) qualified by the words "identically disclosed or described as set forth in section 102 of this title" which appear in Section 103 of the same Act?

4. If a patent claim satisfies all the conditions for patentability set forth in sub-sections (a) and (c) through (g) of Section 102, and also Section 103 of Title 35 U. S. Code, may it be held invalid under Section 102(b) on a publication if the invention defined by the claim is "not identically disclosed or described" in such publication, as required by Section 103?

5. If the pilot model of the Bros roller, as exhibited at the 1948 Road Show, embodied the elements set forth in the claims of Bros et al. patent No. 3,610,557, but was not, more than one year prior to the date of the application for the patent, sold or offered for sale, was not used for the purpose for which it was made, was not loaded or operated either publicly or commercially, or privately or experimentally, and was not reduced to practice, either actually or constructively, until within the one year period before filing, do the photographs, drawings and description of said

roller, as found in the Bros pamphlet (D.X. 4), even if they be held to disclose the entire claimed structure, constitute a bar to the validity of the patent under § 102(b) Title 35 U.S. Code?

6. Did the District Court's substitute Finding No. 21 (R. 50) justify the Conclusion 2 (R. 43) that as a matter of law each of the four claims of the Bros patent in suit "is invalid under the provisions of 35 U. S. Code § 102(b)?

STATUTES INVOLVED

The questions presented herein, while embraced within the constitutional provisions for the issuance of patents (Art. 1, Sec. 8, cl. 8), and the patent laws of the United States enacted pursuant thereto, are particularly concerned with three sections (101, 102 and 103) of the relatively recent 1952 Patent Act (66 Stat. 792, Title 35 U.S.C.A.), which sections replaced the single Section 31 of the previous Act, R.S. §4886, all of which sections are reprinted at A-19-A-21.

STATEMENT OF THE CASE

This is a declaratory judgment action which was brought by plaintiffs Browning Manufacturing Co. and Shovel Supply Co., Inc. against Bros Incorporated for the purpose of adjudicating the issues of validity and infringement as to all four claims of the Bros et al. patent No. 2,610,557. The U. S. District Court for the District of Minnesota had jurisdiction by reason of the provisions of 28 U.S.C. §1338, § 2201, §2202, and §1332. Defendant, Bros, filed Answer, including Counterclaim asserting infringement by plaintiffs, to which plaintiffs replied, and issue was joined.

Plaintiffs' motion for summary judgment was denied

by the District Court (R. 8-21), the case was tried to the Court, which, speaking through the Honorable Judge Gunnar H. Nordbye (R. 21-34, and 49-52), concluded the patent to be "invalid under the provisions of 35 U.S. Code §102(b)," (R. 43) and accordingly gave judgment to plaintiffs while dismissing defendant's counterclaim. The issue of infringement was not decided and is not here involved. On appeal the judgment was affirmed by the Court of Appeals for the Eighth Circuit (A-1) and this Petition followed.

Unlike most patent cases this one does not bring up for review the customary defenses of anticipation, lack of invention, want of novelty, obviousness, prior knowledge, prior use and sale, etc. These and many other issues were vigorously litigated but were resolved here by the District Court, as they were in the Sixth Circuit courts, in favor of the patent. In short, the device of the Bros patent has fulfilled a high standard of invention, in both circuits, and since plaintiffs did not appeal the question of invention that issue is closed.

The Pneumatic Roller Compactor of the patent, as shown in sheets 1 and 2 of the drawings thereof (R. 165-166), comprises a generally rectangular hollow body having a transversely extending arched recess in which are disposed two pair of pneumatic tired supporting wheels. A draft beam for attachment to a tractor extends back through the arched recess, to form a tie bar between the lower ends of the recess walls. The supporting wheels are secured to a pair of fore-and-aft rocker beams, which also serve as reinforcing spacers between the recess walls at points spaced laterally from the draft beam.

The four claims of the patent are reproduced, verbatim but in analytical form, at A-21-A-25, and appear, in con-

densed form. (A-10-A-11) in the decision by the Sixth Circuit Court of Appeals.

In July 1948, one year and four months prior to the filing date of the application for the patent in suit, petitioner Bros publicly displayed a so-called pilot model of the compactor at a Road Show in Chicago. The machine was not for sale nor even offered for sale. It had not been used, operated or even tested. In fact, and as noted in the District Court's Finding 14 (R. 39):

> "It never was loaded and operated, either publicly or commercially, or for that matter, either privately or experimentally. Experimental testing on the roller does not appear to have been conducted until some months had passed subsequent to the Road Show."

That Finding was not challenged, by either party. The experimental testing referred to did not occur until December 1948, or within the one year statutory time limit for filing of the application.

Turning to the Bros pamphlet (Def. Exh. D-4, R. 163-164) the District Court, in its Findings 19, 20 and 21 (R. 40-42 and 50-51) and Conclusion of Law 2 (R. 43), as affirmed by the Eighth Circuit Court of Appeals, holds that it was a printed publication more than one year prior to the Bros filing date and that the invention of the patent was described in the pamphlet, so that "said patent, with respect to each of the four claims therein, is invalid under the provisions of 35 U.S. Code § 102(b)."

In the Eighth Circuit Court of Appeals defendant did not challenge the finding that the pamphlet was distributed at the Road Show in July 1948, but did challenge the courts' conclusion that it describes the invention of the patent within the purview of 35 U.S. Code § 102(b).

In the Sixth Circuit Court of Appeals three attempts were made by the defendant (infringer) in that case to modify mandate for the purpose of permitting that defendant to establish the same identical Bros pamphlet (R. 163-164) as a bar to the validity of the Bros et al. patent 2,610,557 under 35 U.S.C. § 102(b), but in each instance the plea was rejected, on the last occasion the Court specifically finding it "to be without merit."

In the Dallas case, now pending before the Fifth Circuit Court of Appeals, the District Court, by its Order of April 6, 1962 (A-17), denied the defendants' motion under Rule 59 FRCP for a new trial, which, too, was based on the same identical ground, namely, that the Bros patent should be held invalid by reason of the pamphlet (Def. Ex. D-4) allegedly constituting a bar to its validity under 35 U.S.C. § 102(b). In this instance the Dallas court not only denied the motion, but did so notwithstanding the fact that the motion was accompanied by a copy of the Minnesota District Court's decision of February 21, 1962 (R. 21) holding the patent invalid under 35 U.S.C. § 102(b).

It will thus be seen that diametrically opposed conclusions have been reached by widely separated Federal courts in three judicial circuits on the same issues of patent statute and patent claim interpretations. These issues are not only of importance to the various litigants in the extensive Bros litigations, and to the industry, but are also of substantial public importance because they arise out of relatively new provisions of the 1952 Patent Act. Under these circumstances, and since this Court has not previously passed on these issues, the granting of certiorari will, it is believed, result in resolving the conflict and clarifying the confusion that now exists.

REASONS FOR GRANTING THE PETITION FOR WRIT OF CERTIORARI

Several issues arise in connection with the particular Questions Presented in this Petition.

The first of these relates to the definition of the invention as found in the four claims of the patent, and the limitations imposed thereon by the Patent Office before allowing the claims. These are primary and critical factors, and perhaps there is no rule in patent law that has been more firmly established by this Court than this—that a claim in a patent defines the invention thereof (*White v. Dunbar*, 119 U.S. 530, 7 S.Ct. 376, 1886), and, if there is any doubt as to its scope or meaning the claim must be read and interpreted with respect to other claims that were rejected and cancelled or amended (*Hubbell v. United States*, 179 U.S. 77, 21 S.Ct. 24, 45 L.Ed. 95).

In the present case neither the District Court nor the Court of Appeals comments on the distinctions between the claims, nor between the claims of the patent and those that were not allowed, and certainly neither decision indicates a clear understanding as to the precise nature and scope of the invention defined by the claims as they appear in the patent.

On the other hand, the Court of Appeals for the Sixth Circuit clearly demonstrated that it had a very complete and clear understanding of precisely what the claimed invention is, even to the point of emphasizing the more critical limitations in the claim abstracts or condensation that appear in its decision of February 19, 1959 (A-10-A-11). For such reason it seems self-evident that when that Court rejected the Bros pamphlet as a bar to validity, it was because it recognized precisely what the invention actually

was and realized that the claimed structure is not disclosed in the pamphlet.

For present purposes it is thought unnecessary to discuss the Bros claims at length. As examples, however, of claim limitations that are significant it will be found that the Sixth Circuit correctly paraphrases claim 1 in part by including:

> "a draft beam extending longitudinally through the lower part of the body, centrally thereof, such draft beam traversing the arch recess between two of such wheels and rigidly connecting opposite wall portions of the recess."

By this limitation claim 1 (which was claim 2 of the application (R. 175)) is clearly distinguishable from claims 3 and 4 of the application (R. 176) that were rejected (R. 179) and subsequently withdrawn (R. 181).

Claim 2 of the patent, which was claim 13 of the application, was rejected by the examiner (R. 190), and was not allowed until it was amended, as shown (R. 180), to include:

> "bearings (26) for the fore-and-aft supports (25) disposed at the lower ends of the arched recess, (with) said supports (25) maintaining the lower ends of the recess wall in parallelism."

Here again, the Sixth Circuit Court of Appeals clearly recognized the existence and importance of this feature in its summarization (A-10-A-11).

There is not the slightest indication that either the Minnesota District Court or the Court of Appeals for the Eighth Circuit recognized the above quoted features in claims 1 and 2 (and other features in claims 3 and 4) as distinguishing those claims from claims that were rejected and cancelled, or withdrawn.

It thus appears that the Eighth Circuit courts were led into conclusions that were not only erroneous but were also in conflict with the claim interpretations arrived at by the Sixth Circuit courts, and such conflict should now be resolved by this Court granting certiorari and answering the first of the Questions Presented in the negative.

The Eighth Circuit Court of Appeals misconstrued Sections 102 and 103, of Title 35 U.S. Code, in failing to recognize how they are distinguishable from the repealed Section 31 of Title 35 U.S. Code (R.S. § 4886), for which they were substituted in 1952, and in not qualifying § 102(b) with limitations clearly imposed thereon by § 103. These are extremely important considerations to the public, as well as to the courts in administrating the patent law, and should therefore be resolved by this Court.

In its position that the 1952 Act made no material changes in the previous act, and that Section 103 does not qualify Section 102, the appellate court relies on revisor's notes (A-7) found in the legislative history of the new Act, and in its own 1923 decision, *Lynch v. Alworth-Stevens Co.*, 294 F. 190, suggesting the possibility of a narrow, hidden meaning.

In doing so, however, the Court of Appeals overlooks or disregards its own 1952 decision in *Warner v. Dworsky*, 194 F.2d 277, wherein it quotes (p. 279) from this Court's decision in *Mackenzie v. Hare*, 239 U.S. 299, 36 S.Ct. 106, clearly holding, as this Court has often held, that debates and reports on the enactment of a bill must give way to the language of the act itself.

The Eighth Circuit decision further demonstrates confusion in statute interpretation as applied to the present situation by its legislative history note (A-7) on Section 103 in which it is correctly stated that:

> "There is no provision corresponding to the first sentence explicitly stated in the present statute (§ 31), but the refusal of patents by the Patent Office, and the holding of patent invalid by the courts on the ground of lack of invention or lack of patentable novelty has been followed since at least as early as 1850."

The Appeal Court's reliance on this quotation is particularly ironical because, as pointed out above, the issues in this case no longer include "lack of invention or lack of novelty." They were decided and in favor of the patent by the Sixth Circuit courts, and also by the Minnesota District Court's decision of February 21, 1962.

Further confusion is generated on this issue by the fact that both Eighth Circuit courts have completely failed to recognize the distinctions, that are so important to this case, and which are inherent in the 1952 Act, between the defense of anticipation in the prior art, to which Section 102(a) is directed; that of prior invention by someone else, to which Section 102(g) is directed; that of obviousness or lack of invention, to which Section 103 is directed; and the one year statutory bar to patentability created by Section 102(b) here relied on by respondents.

Here then are four specifically different defenses, establishable by different types of evidence. Yet, and even though they are statutory distinctions, they were ignored by the trial court and were noted and rejected by the Court of Appeals.

The authorities relied on by the District Court (R. 29) are *Trico Products Corp. v. Delman*, 180 F.2d 529, and *Application of Pappas*, 214 F.2d 172. The *Trico* decision was written two years before the 1952 Act became law and the claims were held "void for want of invention" involving "neither invention nor mechanical skill." The *Pap-*

pas decision affirmed the rejection of claims as being "anticipated." Neither decision is relevant to the present issue of patentability under § 102(b).

The Court of Appeals also cites two decisions (A-6) *Collins v. Owens*, 310 F.2d 884, and *Midland Flour Milling Co. v. Bobbitt*, both of which are equally foreign to the present issue. Thus, the *Midland* case, of 1934, a prior art publication was held to be an "anticipation" and the patent was held "void for want of invention," while in the *Collins* case a patent was also held invalid "for lack of invention" and for "anticipation," neither of which is a defense under Section 102(b).

As between the issues in the *Collins* case and those here presented the Court of Appeals stated (A-6), that "We perceive no controlling distinction," thus further emphasizing the need for judicial recognition of the distinction and proper solution to an important problem by this Court.

Another issue of substantial importance, and on which there is also a paucity of court decisions, is that noted in the fifth of the Questions Presented, which assumes but by no means admits, that the precise combinations of elements set forth in the respective claims of the Bros et al. patent are disclosed in the Bros pamphlet (Def. Ex. 4, R. 163-4).

This issue, on which the Eighth Circuit courts also elected to remain silent, is predicated on the premise that if the pilot model of the Bros machine was not sold nor offered for sale, and was not loaded, operated, or tested, publicly, commercially, privately or even experimentally, more than one year before the Bros filing date, as the trial court found to be the case (F. 39), there could have been no reduction to practice of the invention, either actually or constructively, prior to November 17, 1948, and consequently the disclosure of such an uncompleted invention in

the Bros pamphlet, if prior to that date, is insufficient to constitute a bar to validity under § 102(b).

The process of inventing includes the familiar steps of conception, drawings, describing, making, experimenting, testing, etc., but it is axiomatic in patent law that an invention does not come into existence as such until it is reduced to practice, either actually, by building and successfully operating a machine embodying the invention, or constructively, by the filing of a formal patent application.

This Court long ago established the rule that tests and experiments are not disclosures of an invention, *Elizabeth v. Pavement Co.*, 97 U.S. 126, 24 L.Ed. 1000. That being the law, and with the Bros machine not even having reached the experimental stage, more than one year prior to the filing date, it is difficult to understand how the portrayal of that machine in the pamphlet can be more effective under § 102(b) than the machine itself. Yet that is precisely what the trial court and the Eighth Circuit Court of Appeals have in effect held.

Thus Question 5 brings before this Court an important issue which the courts below have not answered and which this Court should resolve.

In rejecting the argument that the words "identically disclosed or described," as found in § 103 qualifies § 102(b) the Eighth Circuit decision (A-7) also rejects or ignores the time honored cardinal rule of this Court that when interpreting related provisions of a statute every word thereof shall, if possible be accorded effect and significance. *Ex parte Public National Bank of New York*, 278 U.S. 101, 49 S.Ct. 43, and *Washington Market Co. v. Hoffman*, 101 U.S. 112, 25 L.Ed. 782.

Both decisions below also fail to recognize the all important distinction between the two sections in that § 102

(b) presupposes the existence of novelty and invention, but denies the patentee the right to a valid patent if he has not timely filed his application, while § 103 denies him a patent if his device does not qualify as an invention. Thus § 103, recognizing want of invention or obviousness "to a person having ordinary skill in the art," opens up the entire area of conjecture, impressions and opinions which bear on that issue, while that is made an exception to § 102(b) where those privileges are not granted.

Unfortunately neither this Court, nor any other court as far as we know, has thus far rendered a decision specifically construing § 102(b) in the light of the requirement that the claimed invention must be "identically disclosed" (per § 103) in the publication for the latter to constitute a bar to patentability, except, of course, for the present Eighth Circuit decision, and if it rejects the plain terms of the statute itself, as seems apparent, certainly the situation is one to which this Court sould be desirous of exercising its jurisdictional authority by granting this petition and deciding the issues raised by the presented Questions 2, 3 and 4.

The f al Question (6) presented to this Court raises an issue that is summarily disposed of by the Court of Appeals as one of fact, but is one that cannot possibly be properly resolved without first recognizing critical limitations in the claim language, statutory prerequisites, and some determination of how far a court may go, if at all, in calling in the mythical person skilled in the art to supply deficiencies in a publication to make it available as a defense under § 102(b), all questions of law.

The evidence in this case, and particularly that produced on cross-examination of respondents' own witnesses (R. 68-70, 75-78, 84, 108-110, 114-118, 122-123 and 142-

143), conclusively demonstrates that if weight be given to critical limitations of the Bros et al. patent claims, such as those quoted on page 12 hereof, as the law requires, then it is simply impossible to find a disclosure of "the invention" in the Bros pamphlet.

But it should here be unnecessary to argue that point because there is no possible way that testimony can alter or enlarge on the disclosure of the circular, which so obviously falls far short of showing the full and exact invention defined by the claims.

The District Court apparently recognized that the Bros "invention" was not "described" in the pamphlet, as required by § 102(b), but then cures this defect by deciding that the missing elements (even though considered critical by the Patent Office) could be supplied by "ordinary mechanical skill" (R. 30), and that "one skilled in the art generally would have no great difficulty in producing a similar device, despite the fact that exact drawings and specifications are lacking" (R. 29).

Having agreed with the Sixth Circuit decisions on the issues of invention and novelty over the prior art the District Judge erred; we submit, in drawing on the prior art and on those skilled in the art, these being liberties that may be resorted to only under the specific language of § 103 but may not be done under the more restrictive provisions of § 102(b). Clarification of this issue by the Supreme Court is very important as it would dispel much of the confusion that now exists in construing the 1952 Patent Act.

CONCLUSION

In view of the foregoing a Writ of Certiorari should issue out of this Court directed to the United States Court of

Appeals for the Eighth Circuit so that the decision of said Court of Appeals as filed May 27, 1963 may be reviewed by this Court and appropriate correction of errors therein be made.

Respectfully submitted,

ANDREW E. CARLSEN
Attorney for Petitioner.

CERTIFICATE OF SERVICE

Three copies of the foregoing Petition for Writ of Certiorari have been served on the respondents by mailing said copies first class air mail, postage prepaid, to respondents' attorneys, Messrs. Parrott & Rankin, Wachovia Bank Building, Charlotte 2, North Carolina, this 3rd day of July 1963.

Attorney for Petitioner

ANDREW E. CARLSEN
417 Plymouth Building
Minneapolis 2, Minnesota
Attorney for Petitioner

Of Counsel:
DOUGLAS L. CARLSEN

INDEX TO APPENDIX

PAGE

Opinion (May 27, 1963) of the Court of Appeals for the Eighth Circuit A-1

Opinion (February 19, 1959) of the Court of Appeals for the Sixth Circuit A-9

Order (February 2, 1960) of United States District Court for Northern District of Texas, Dallas Division A-16

Opinion (April 6, 1962) and Docket Entry (April 17, 1962) by United States District Court, Dallas, denying Motion for new trial A-17, A-19

Repealed 35 U. S. Code, Section 31 ..... A-19

Sections 101, 102 and 103 of Title 35 U. S. Code (the 1952 Patent Act) A-21, A-22

Claims 1, 2, 3 and 4 of Bros et al. Patent No. 2,610,557 ..... A-21, A-22, A-23, A-24, A-25

APPENDIX

UNITED STATES COURT OF APPEALS FOR THE EIGHTH CIRCUIT

No. 17,169.

Bros Incorporated,

Appellant,

vs.

Browning Manufacturing Co. and Shovel Supply Co., Inc.,

Appellees.

Appeal from the United States District Court for the District of Minnesota.

[May 27, 1963.]

Before Sanborn and Blackmun, Circuit Judges, and Stephenson, District Judge.

Sanborn, Circuit Judge.

This is an appeal from a judgment for the plaintiffs, Texas corporations, (appellees) in an action brought by them in June, 1959, against Bros Incorporated, a Minnesota corporation, (appellant) (Bros) to secure a declaratory judgment that its United States Patent No. 2,610,557 for a "Pneumatic Roller Compactor," issued to C. W. Bros, et al., September 16, 1952, on an application filed November 17, 1949, was invalid. In their complaint the plaintiffs alleged that they had been notified by the defendant that the pneumatic roller compactors made by the plaintiffs infringed the patent in suit. They alleged that the patent was invalid for several reasons. The one with which we are concerned is based on 35 U.S.C. § 102, which provides in part:

"A person shall be entitled to a patent unless—

* * * * *

"(b) the invention was patented or described in a printed publication in this or a foreign country * * * more than one year prior to the date of the application for patent in the United States * * *."

The complaint alleged that in a printed pamphlet or advertising folder, entitled "50 Ton Compactor With Oscillating Wheels," which had been prepared and pubicly distributed by the defendant at the "Road Show of the American Road Builders' Association held in Chicago, Illinois, from July 16, through July 24, 1948," the claimed invention was fully described and illustrated. This the defendant in its answer denied. By a counterclaim, it asserted that the plaintiffs were infringers, and asked for an injunction and an accounting. The plaintiffs joined issue on the counterclaim.

The case was tried to the District Court after it had denied a motion of the plaintiffs for a summary judgment. The trial judge filed a comprehensive Memorandum Decision and detailed Findings of Fact and Conclusions of Law. He stated that he was in full accord with the views expressed by the United States Courts of Appeals for the Fifth and Sixth Circuits in sustaining the patent as to the patentable novelty of the claimed invention. See *Bros, Incorporated v. W. E. Grace Manufacturing Co.*, 5 Cir., 261 F.2d 428, and *Gibson-Stewart Company, Inc. v. Wm. Bros Boiler and Manufacturing Company*, 6 Cir., 264 F. 2d 776, certiorari denied 360 U. S. 929. He determined, however, that the publication of the description of the Bros invention in the pamphlet distributed at the Chicago Road Show rendered the patent invalid.

Based upon the Findings of Fact and Conclusions of Law, the trial court entered judgment for the plaintiffs, determining:

"That each and every claim of United States Letters Patent No. 2,610,557, issued September 16, 1952, on

application filed November 17, 1949, is invalid, because the alleged invention therein was described in a printed publication (Defendant's Exhibit D-4, a pamphlet entitled '50 Ton Compactor with Oscillating Wheels') which was distributed by defendant at the July 1948 'Road Show' of the American Road Builders Association at Chicago, Illinois, more than one year prior to the filing of the application for said patent on November 17, 1949."

In its Reply Brief, Bros says:

> "Stated in its simplest form the sole question presented to this Court for decision is whether or not the Bros pamphlet, Defendant's Exhibit D-4, describes the invention defined by the claims of the patent in suit, so as to render the patent invalid under the provisions of 35 U.S. Code, No. 102(b)."

No question is raised with respect to the finding that more than one year before the patent was applied for, there had been a distribution of the Bros printed pamphlet (Defendant's Exhibit D-4), descriptive of its "compactor", at the July 1948 Road Show in Chicago. All that Bros now contends is that the description of the invention in its Road Show pamphlet was insufficient to invalidate its patent, under 35 U.S.C. § 102(b).

The Findings of the trial court relative to the pamphlet in suit read as follows:

> "Exhibit D-4 is a one-piece four-page black and white pamphlet. The cover page is entitled '50 Ton Compactor with Oscillating Wheels' with a Bros insignia reading 'Bros'. At the bottom there is printed 'Wm. Bros Boiler & Mfg. Co., Minneapolis, Minnesota.' The inside pages consist of four photographs of the machine showing it attached to a tractor. The photographs are taken from various angles. One of the photographs shows the oscillating effect of the wheels as the machine moves over uneven ground. The print-

ed material on the inside pages consists of the following:

" 'FULL WIDTH COVERAGE PREVENTS HAULING EQUIPMENT FROM "BOGGING DOWN"

" 'Specifications

" 'Empty shipping weight 24,000 lbs.

Maximum loaded weight, 100,000 lbs.

Main Tire Sizes (4), 18:00 x 24-24 ply

Maximum Tire Air Pressure for 100,000 lb. load, 70 lbs. per sq. in.

Minimum Tire Air Pressure for empty roller, 50 lbs. per sq. in.

Tire Size (when front dual wheel dolly used) (2), 12:00 x 20-14 ply

Body capacity, 640 cu. feet

Tongue Neck Capacity, 25 cu. ft. or 187 gal.

Maximum travel speed with 100,000 lb. gross load, 5 mi. per hr.

Rolling width, 8' 10"

Overall body and tongue length, 26' 6"

Overall body width (less outside tires), 8 feet

Overall height on tires, 7' 9½"

" 'THE NEW BROS GIANT SIZE PNEUMATIC TIRED 50 TON ROLLER

" '(Model No. 6 with Oscillating Wheels)

" 'A new step towards better compaction to speed up the job. Especially designed for airport, embankment and heavy fill work. Flexible loads starting at 24,000 pounds empty to 100,000 pounds

loaded. Especially designed to prevent hauling equipment from "bogging down" and keeping wagons and scrapers on their regular jobs. Gives an 8' 10" roller coverage and easily pulled when used in combination with a LaPlant-Choate tractor Model T-300 or any large crawler tractor. Also comes equipped with dual front wheel dolly for towing behind tractors. Oscillating wheels permit proper angle coverage.

" Price $12,500.00 f.o.b. Minneapolis, Minn."

"On the fourth or back page of the pamphlet are two white on black drawings of rollers. Each of the drawings shows side and top views of the machine and on one drawing the machine has a 'two-wheel dolly' attached to it and on the other a 'LaPlant-Choat Tractor' is attached.

"The published pamphlet, Defendant's Exhibit D-4, taught to the industry the essential elements and features of the patent in suit and the impelling weight of the evidence amply supports the finding, and the Court does find, that the essence of the invention, that is, the inventive concept which is the basis for the claims of this patent, was fully disclosed in this pamphlet and enabled one skilled in the art to build and produce the roller compactor described in this patent."

The trial court based its judgment for the plaintiffs upon 35 U.S.C. § 102(b) because there was competent evidence which convinced the court that the invention disclosed by the patent was described in the pamphlet with sufficient particularity to enable one skilled in the art of constructing such machinery to reproduce the invention without having to resort to the patent.

This same question as to the sufficiency, under this same statute, of the description of an invention in a foreign publication ante-dating by more than one year the application for a patent, was raised and decided adversely to the owner

of the patent in *Collins v. Owen*, D.C. N.D. Iowa, 199 F. Supp. 61, affirmed, 8 Cir., 310 F. 2d 884 (1962).

If, in the instant case, there was a substantial evidentiary basis for the trial court's determination that the description of the invention in the defendant's Road Show pamphlet was, alone, sufficient to enable one skilled in the art to produce the invention, the judgment must be affirmed. *Collins v. Owen, supra*, page 887 of 310 F. 2d. We said in that case:

> "The test for determining the adequacy of the description of an invention in a foreign publication is, as the trial court recognized, that 'the knowledge "derived from the publication must be sufficient to enable those skilled in the art or science to understand the nature and operation of the invention, and to carry it into practical use." * * *.'"

See, also, *Midland Flour Milling Co. v. Bobbitt*, 8 Cir., 70 F. 2d 416, 418. The same test is, of course, applicable to the description of an invention in a domestic publication.

Bros contends that in the *Collins* case the issues were not the same as in the instant case and that the *Collins* case arose out of a different situation. We perceive no controlling distinction. In each case the key issue was the adequacy of the published description of the invention. In this case, as in *Collins*, the issue was, under the evidence, clearly one of fact to be determined by the trial court, and is not a question of law for this Court to decide.

It is argued on behalf of Bros that the trial court misinterpreted § 102(b), which, it is contended, when read in connection with § 103,[1] makes any description of an inven-

[1] § 103, Title 35 U.S.C.:
"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

tion in a printed publication inadequate to invalidate a patent unless the invention is "identically disclosed or described."

The legislative history of the 1952 revision of the Patent laws (Title 35 U.S.C., 1946 Ed.) refutes the contention that § 103 was intended to modify or affect in any way § 102(b). The "Revision Notes", attached to and made a part of the Reports of the Judiciary Committees of Congress, relating to the revision, appear on pages 2403-2428, Vol. 2, U. S. Code Congressional and Administrative News, 82nd Congress; Second Session, 1952. The Report of the Judiciary Committee of the Senate, with the "Revision Notes" attached, appears on pages 2394-2428. The notes on pages 2410-2411 read as follows:

"SECTION 102—SECTION REVISED

"Paragraphs (a), (b) and (c) are based on 35 U.S.C., 1946. ed., § 31 * * *.

"No change is made in these paragraphs other than that due to division into lettered paragraphs. * * *

* * * * *

"SECTION 103—NEW SECTION

"There is no provision corresponding to the first sentence explicitly stated in the present statutes, but the refusal of patents by the Patent Office, and the holding of patents invalid by the courts, on the ground of lack of invention or lack of patentable novelty has been followed since at least as early as 1850. This paragraph is added with the view that an explicit statement in the statute may have some stabilizing effect, and also to serve as a basis for the addition at a later time of some criteria which may be worked out.

"The second sentence states that patentability as to this requirement is not to be negatived by the manner in which the invention was made, that is, it is imma-

terial whether it resulted from long toil and experimentation or from a flash of genius."

As this Court, not infrequently in the past, has said:

> "* * * [T]he plain, obvious and rational meaning of a statute is always to be preferred to any curious, narrow, hidden sense that nothing but the exigency of a hard case and the ingenuity and study of an acute and powerful intellect would discover."

Lynch v. Alworth-Stephens Co., 8 Cir., 294 F. 190, 194, and cases cited.

The suggestion that the trial court failed to give appropriate weight to the refusal of the courts of the Fifth and Sixth Circuits to re-open the cases sustaining the validity of the patent, so as to enable the defendants in those cases to inject the issue of invalidity because of the Road Show pamphlet, is without merit. The plaintiffs here were not parties to those cases. The motions to reopen were made after judgment, and were addressed to the discretion of the courts which had decided the cases. The plaintiffs were free to bring this action in the District of Minnesota, and the trial court had the duty and responsibility of deciding for itself the issues presented.

The decision of the District Court, based as it is upon an issue of fact, is conclusive upon us. "This Court, upon review, will not retry issues of fact or substitute its judgment with respect to such issues for that of the trial court." *Cleo Syrup Corporation v. Coca-Cola Co.*, 8 Cir., 139 F. 2d 416, 417, certiorari denied 321 U. S. 781.

Unfortunately, the appellant and the appellees did not cooperate in the preparation of a short and concise printed record on appeal. The appellees considered the appellant's printed record inadequate and filed a printed supplement. They ask that its cost be taxed against the appellant, which they assert had refused to cooperate. This the appellant

denies. We shall not attempt to resolve this controversy. The appellees' request is denied.

The judgment appealed from is affirmed.
A true copy.

Attest:

Clerk, U. S. Court of Appeals, Eighth Circuit.

Filed February 19, 1959. Carl W. Reuss, Clerk

No. 13,500

UNITED STATES COURT OF APPEALS FOR THE SIXTH CIRCUIT

Gibson-Stewart Company, Inc., *Appellant*

v.

Wm. Bros Boiler and Manufacturing Company, *Appellee*

Appeal from the United States District Court for the Northern District of Ohio

Decided February 19, 1959

Before Allen, Chief Judge; Martin, Circuit Judge; Gourley, District Judge.

Martin, Circuit Judge. In this suit for patent infringement, the able and experienced district judge held the four claims of Bros et al., Patent (No. 2,610,557) to be valid and infringed by the appellant, Gibson-Stewart Company, Inc.

As stated by the patentee, the invention in the patent in suit relates to the art of compacting earth for roads,

highways, airport runways, fills for dams, etc., where deep penetration and uniform but maximum density are important objectives and where the primary purpose is to provide a novel, efficient and practical pneumatic-tired compactor that will effectively, yet economically, meet these rigid objectives or requirements. The inventor stated that a typical exigency is presented by airport runways, which must receive and support aircraft weighing as much as three hundred thousand pounds. It was said further, in the patent application, that the resulting impact is such as to break down the runway pavement, unless properly constructed by base courses and sub-grades which have been compacted to an extremely high degree of denisty and to a depth of as much as five to six feet below the surface. The inventor then goes further to detail the specifications in the patent and makes four claims; all of which, as heretofore stated, were upheld by the district court.

Claim One is for an earth compaction roller comprising a hollow body member adapted to receive weight-producing ballast and having a transversely extending arched recess between its front and rear ends, an axially aligned series of pneumatic-tired wheels mounted in such recess to support the body member with its center of gravity substantially over the wheels, and a draft beam extending longitudinally through the lower part of the body, centrally thereof, such draft beam traversing the arch recess between two of such wheels and rigidly connecting opposite wall portions of the recess.

The other claims are in substance, as follows:

Claim Two. A unitary body structure having the central recess and employing two pairs of wheels—one of which is under each side—each pair being carried by the support beam additionally operating to maintain the lower ends of the recess wall in parallelism.

Claim Three is similarly limited to the use of four wheels and mountings in the recess; but this claim is directed specifically to the feature of arranging the four wheels so that they will carry equal loads and be spaced to produce equal compaction pressures in equally spaced paths.

Claim Four, in a general way, is similar to Claim Three; but it includes the parallelism-maintaining characteristic in addition to the wheel-spacing arrangement, which is specifically confined to an arrangement in which the space between any two wheels is less than the width of the tread of one wheel so as to prevent any substantial movement of earth upwardly between the tires.

The district judge received in evidence various exhibits revealing the prior art. He heard testimony of experts and other witnesses, analyzed the case and rendered an oral opinion, subsequently revised. He stated that "the defendant at the trial admitted infringement was present if the patent claims were valid."

On the issue of validity of the patent, the judge considered it more than a mere aggregation or assembly of wellknown elements in the road-building art where densification of the ground is one of the principal accomplishments desired and compaction is another. He thought that the need for a marketable machine for compaction had been fulfilled by the appellee in a new and useful way, even though it had been necessary to use the prior art and structures to accomplish it. He considered that the problem solved by the inventor had been to bring together in a compact, efficient unit the necessary elements to meet a need by the use of means which would make the completed structure an easy one to manipulate, while accomplishing all that the old machines and structures had done. He stated that the arched recess is old and, standing alone, put nothing new into the combination of elements, being useful nevertheless. He said further that the oscillation and rocker-beam idea was not new, and that the appellee did not even claim originality or novelty for most of the elements embraced in the structure. But he well reasoned that novelty, usefulness and commercial acceptance for the manner in which the known elements were put together—not as a mere aggregation, but as a combination which accomplishes the job sought to be accomplished in a new and better way—was manifest.

The judge asserted that it had been conceded on the trial

that the structure had met with commercial success which, had there been doubt about the validity of the patent, might have been sufficient to maintain validity. There was no doubt in the mind of the judge as to validity of the patent.

Judge Jones went into further discussion of the elements of the patent and concluded that the arrangement of the patented structure, distributing the load equally in all portions as it does, required more than ordinary mechanical and engineering skill for accomplishment. The distinguished jurist thought that, on the whole, the equalizing of the weight by the distribution of the wheels of the patent in suit and the recess part were not shown exactly by anything in the prior art. He considered the Browning structure in the prior art distinguishable, in that the load distributed to the two rollers—when taken apart—would not have been adequate to accomplish the purpose of the patent structure.

The judge reasoned that the spacing of the wheels themselves in Browning, although apparent in some structures, was staggered differently because they were alternating wheels, with the result that the whole area could be covered by two separate sets of wheels: one at one end of the structure and one at the other. He concluded that the arrangement of the patent in suit accomplished the purpose of bringing the whole load to bear uniformly on the sub-surface and effected in a more concise, compact way what had been attained previously by the staggered wheels.

Accordingly, a permanent injunction was issued against infringement by appellant of the patented structure; and the customary reference to a Master was ordered for an accounting to ascertain the profits and damages due by appellant to appellee. We are of opinion that the judgment of the district court should be affirmed.

Williams Manufacturing Co. v. United Shoe Machinery Corp., 121 F. (2d) 273, 277 (C. A. 6), decided June 27, 1941 [affirmed, 316 U. S. 365], was the first case at that time in which, for some fifteen years, the Supreme Court in an opinion had upheld the validity of a patent. In that case, Judge Simons, speaking for our court, said: "To the pre-

sumption of validity that attaches to a granted patent, where the most pertinent prior art has been cited against it in the patent office, there must probably now be added the force of a growing recognition of finality that is generally being accorded to administrative determinations supported by evidence, on the ground that the administrative agency is expected to have developed an expertness in its specific field beyond what may be expected from the courts wherein adjudications range the whole field of human controversies. It is true, of course, that in the most strict sense, the granting of a patent is not, except when an interference is declared, the result of an adversary proceeding, as in usual administrative determinations of agencies exercising quasi-judicial functions. Nevertheless it wears, in the broader sense, an adversary aspect, since patent office examination protects the public against unmerited monopoly, and so the public, as represented by the examiner, is always impliedly in adversary position to the application just as it is ever a third party to an infringement suit. *Kellogg Switchboard & Supply Co. v. Michigan Bell Telephone Co.*, 6 Cir., 99 F. 2d 203. To the inferences in support of validity thus noted, must now be added the implication of correctness that attaches to the findings and conclusions of the District Judge who heard the testimony of the witnesses and saw the machines in operation." It was pointed out, moreover, that an infringer who assails the validity of a patent, fair upon its face, bears a heavy burden of persuasion and fails unless his evidence has more than a dubious preponderance.

In *Trabon Engineering Corporation v. Dirkes*, 136 F. (2d) 24, 27 (C. A. 6), Judge Simons gave expression to a principle directly pertinent in the present controversy. He stated that "long recognition of an existing problem in any art, and the advantages to accrue to an industry from its solution, have been considered as highly persuasive of invention when success is finally achieved; that sometimes achievement is revolutionary, but more often an inventor begins where others leave off, and perceives the vital forward step to which predecessors had been blind."

It is established, of course, that in a patent case the findings of fact of the district court—unless clearly erroneous—should not be disturbed. *Modern Products Supply Co. v. Drachenberg*, 152 F. (2d) 203, 207 (C. A. 6). This principle applies to issues of both validity and infringement.

Illustrative cases from this circuit, holding that a combination patent should not be invalidated by the mere fact that certain elements of the combination are old if invention inheres in the combination, are, among others: *General Motors Corporation v. Swan Carburetor Co.*, 88 F. (2d) 876, 887 (C. A. 6); *International Visible Systems Corp. v. Remington-Rand, Inc.*, 78 F. (2d) 606 (C. A. 6).

It would seem that the opinion of the Supreme Court in *Great Atlantic & Pacific Tea Company v. Supermarket Equipment Corp.*, 340 U. S. 147, is not applicable here because of the vast difference in the complexities of the two inventions. There, the condemned invention consisted simply in opening up the apex of the equivalent of an ordinary pool ball rack so that the legs of the triangle became parallel to each other and perpendicular to the base, the open rack being merely hand-pushed along an elongated table in the handling of food sold in stores. The pushing element was not automatic—not even mechanical.

Here, as has been previously shown, the huge patented device was highly complicated and most ingeniously designed; and it served a purpose not theretofore known for practical requirements in its field.

Judge Allen has written for this court a carefully considered opinion in which are set forth several principles applicable to the instant case. *Cold Metal Process Company v. Republic Steel Corp.*, 233 F. (2d) 828 (C. A. 6). The opinion contains a wealth of citations of value to the patent bench and bar. To quote a few excerpts, the opinion stated: [p. 837] "The long-standing want and insistent demand satisfied by the patentee demonstrate the existence of invention. *Goodyear Tire & Rubber Co., Inc. v. Ray-O-Vac Co.*, 321 U. S. 275, 279, 64 S. Ct. 593, 88 L. Ed. 721; *Watson v. Heil*, 4 Cir., 192 F. (2d) 982, 985. * * * [pages

838-9] In order to secure a true and patentable combination of old elements, the elements must co-act to produce the result achieved, the result must be new and useful, and the method of operation must be new. *Great Lakes Equipment Co. v. Fluid System, Inc.*, 6 Cir., 17 F. (2d) 613, 617. If the method of operation is new and the result is new, the old elements perform a new function in their new environment." The opinion stated also: [p. 837] "The best of the art relied on here [as in the instant case] was before the Patent Office and this fact strengthens the presumption of validity. *Modern Products Supply Co. v. Drachenberg*, 6 Cir., 152 F. (2d) 203, 205, certiorari denied 327 U. S. 806, 66 S. Ct. 964, 90 L. Ed. 1030."

As we think has been hereinbefore indicated, the trial judge made an adequate, succinct and accurate statement of the reasons for which the claims of the patent were considered valid. There was ample basis in the testimony of expert witnesses to support his deductions. In the light of the record, we think it would be an all too sweeping and incorrect generalization to say that the subject matter of the patent in suit would be obvious to those schooled in the art at the time the invention was disclosed. We think the objective was attained by the claims of the patent to provide a pneumatic tired roller, so constructed and of such weight as to produce compaction of sufficient magnitude to bring about deeper penetration and more intense densification than had been accomplished before, without the sacrifice of rigidity of body or maneuverability. The roller was also kept within the limitation of ground area.

Upon careful analysis, the claims of the patent in suit seem to present a distinctive inventive concept which had no equivalency in the prior art. We think that neither the oscillating wheels of Grace, nor the body in Browning, nor Porter's wheel-spacing represents anticipation of the combination patent in suit.

Accordingly, for the reasons set forth in this opinion and in that of the United States District Judge as herein analyzed, the judgment of the district court is affirmed.

JUDGMENT

(Filed February 19, 1959)

Appeal from the United States District Court for the Northern District of Ohio.

This cause came on to be heard on the transcript of the record from the United States District Court for the Northern District of Ohio, and argued by counsel.

On consideration whereof, it is now here ordered and adjudged by this court that the judgment of the said District Court in this cause be and the same is hereby affirmed.

IN THE UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF TEXAS
DALLAS DIVISION

BROS INCORPORATED,

Plaintiff,

v.

W. E. GRACE MANUFACTURING COMPANY and WILLIAM E. GRACE,

Defendants.

Civil Action No. 7608

Patent No. 2,610,557

ORDER ON MOTIONS AND PETITION

This Cause having come on for hearing of

A. Defendants' Motion to continue in effect the Order entered herein on July 11, 1959 staying the accounting, and

B. Defendants' Petition for Leave to Reopen, and

C. Plaintiff's Motion for Accounting.

And the parties having been heard it is hereby Ordered, Adjudged and Decreed, that

(A) Defendants' Motion to continue in effect the Order entered herein on July 11, 1959 staying the accounting, and Defendants' Petition for Leave to Reopen, are denied, and

Plaintiff's Motion for Accounting is granted.

An Order may be entered appointing Honorable Ralph W. Currie, 1507-10 Praetorian Building, Dallas, Texas, Special Master with instructions to proceed at once with the accounting.

/s/ T. WHITFIELD DAVIDSON,
United States District Judge.

Dated Feb. 2, 1960.

IN THE DISTRICT COURT OF THE UNITED STATES
FOR THE NORTHERN DISTRICT OF TEXAS
DALLAS DIVISION

No. 7608 Civil

BROS INCORPORATED,

vs.

W. E. GRACE MANUFACTURING COMPANY, and WILLIAM E. GRACE

April 6, 1962.

The Court: Judge Atwell passed on this case. I don't know what kind of representations were made, or how forceful was the argument, but, we regard Judge Atwell

as a competent jurist; for many years he was so recognized, and the Circuit Court at New Orleans affirmed his decision, therefore, we have no discretion except to proceed under the decision as rendered by the Circuit Court, and that was to ascertain the amount of damage.

After some discussion among counsel a master was appointed, and the Master's report was attacked and that has been delayed.

We do not consider it mandatory or reasonably expected of one court to set aside or withhold action under a judgment of the Fifth Circuit, because I believe this judgment was rendered in the District Court of another state. That being the case we do not feel we should undertake to withhold any action had under the decision of the Fifth Circuit.

I think, however, the defendant has his remedy, and his remedy should be before that court or before the Supreme Court. Then he can, in presenting this case to that court, which is a court of great discretion, and he can set up this other judgment and present it, and if it is overruled perhaps the Supreme Court will sustain the Minnesota case, and then you have a clear cut question for the Supreme Court. So instead of us taking this back on the trial court docket, I think we will leave it, and let the appeal go forward, and let your request and your grievance be presented there.

The motion will be denied.

CLERK'S OFFICE

United States District Court for the

NORTHERN DISTRICT OF TEXAS
DALLAS DIVISION

Civil Action No. 7608

BROS INCORPORATED

vs.

W. E. GRACE MFG. CO. and WILLIAM E. GRACE

There was entered on the docket Apr 17, 1962 an order. Motion by defendants under Rule 59 denied.

JOHN A. LOWTHER, Clerk.

REPEALED 35 U. S. CODE NO. 31

(This Section 31 as it read prior to 1952 Act. and which was replaced by new Sections 101, 102 and 161, read)

INVENTIONS PATENTABLE

31. *Inventions patentable*

Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than

one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor.

R. S. § 4886; Mar. 3, 1897, c. 391, § 1, 29 Stat. 692; May 23, 1930, c. 312, § 1, 46 Stat. 376; Aug. 5, 1939, c. 450, § 1, 53 Stat. 1212.

35 U. S. CODE NO. 101

101. *Inventions patentable*

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

35 U. S. CODE NO. 102

102. *Conditions for patentability; novelty and loss of right to patent*

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the

date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

35 U. S. CODE NO. 103

103: *Conditions for patentability; non-obvious subject matter*

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Bros et al. Patent 2,610,557. Claim 1

1. An earth compaction roller comprising

(a) a hollow body member adapted to receive weight producing ballast

(aa) and having a transversely extending arched recess between its front and rear ends,

(b) an axially aligned series of pneumatic tired wheels mounted in said recess

(bb) to support the body member with its center of gravity substantially over the wheels, and

(c) a draft beam extending longitudinally through the lower part of the body, centrally thereof,

(cc) said draft beam traversing said arched recess between two of such wheels and rigidly connecting opposite wall portions of the recess.

Bros et al. Patent 2,610,557, Claim 2

2. An earth compaction roller comprising

(a) a unitary hollow body member adapted to receive weight producing ballast,

(aa) and having a transversely extending arched recess substantially midway its front and rear ends,

(b) two pair of pneumatic tired wheels mounted in said recess, one pair under each half portion thereof,

(bb) to support the body member with its longitudinal center of gravity substantially over the wheels and so the entire weight of the body will be transversely distributed to both pairs of wheels,

(c) a shaft in the recess mounting each pair of said wheels,

(d) a fore-and-aft extending support for each shaft positioned between each pair of wheels

(dd) with each support oscillatably mounted whereby the wheels of each pair have freedom for oscillating

movement with respect to its side of the body member and

(e) bearings for the fore-and-aft supports disposed at the lower ends of the arched recess,

(f) said supports maintaining the lower ends of the recess wall in parallelism.

Bros et al. Patent 2,610,557. Claim 3

3. An earth compaction roller comprising

(a) a unitary hollow body member forming a single frame and adapted to receive weight producing ballast,

(aa) said body having a recess extending transversely thereunder, and across its entire width,

(b) four pneumatically tired wheels coaxially disposed in said recess, two under each side of the body member, said wheels being mounted in pairs,

(c) a shaft in the recess for mounting each pair of wheels,

(d) a fore-and-aft extending support in the recess for each shaft positioned between the wheels of each pair with the support oscillatably mounted and with its axis fixed and respect to the body member, whereby the wheels of each pair are free to oscillate about the axis of said supports,

(e) and a bearing beam disposed at each lower end of the transverse recess and in which the fore-and-aft supports are mounted,

(f) the wheel supporting shafts being parallel with and equidistantly spaced from said bearing beams,

(g) the entire imposed load of the body member and its ballast being transmitted equally to the four wheels.

(h) the wheels being spaced from each other and with the spacing between each two adjacent wheels being equal whereby the load supporting tires will compact the earth in four equally spaced paths and with equally distributed pressure on each path.

Bros et al. Patent 2,610,557. Claim 4

4. An earth compaction roller comprising

(a) a unitary hollow body member forming a single frame and adapted to receive weight producing ballast,

(aa) said body having a recess extending transversely thereunder, and across its entire width,

(b) four pneumatically tired wheels coaxially disposed in said recess, two under each side of the body member, said wheels being mounted in pairs,

(c) a shaft in the recess for mounting each pair of wheels,

(d) a fore-and-aft extending support in the recess for each shaft positioned between the wheels of each pair with the support oscillatably mounted and with its axis fixed with respect to the body member, whereby the wheels of each pair are free to oscillate about the axis of said support,

(e) reinforcing means at the lower ends of the transverse recess and in which the support is mounted with the supports acting to maintain said lower ends in parallelism and in spaced relation,

(f) the entire imposed load of the body member and its ballast being transmitted equally to the four wheels,

(g) the wheels being spaced from each other and with the spacing between each two adjacent wheels being equal whereby the load supporting tires will compact the earth in

four equally spaced paths and with equally distributed pressure on each path,

(h) and the spacing between the treads of each two adjacent tires being substantially less than the width of the tread of either of such tires whereby the compaction forces will not exert any substantial movement of earth material upwardly between the tires.

LIBRARY
SUPREME COURT, U. S.

Office-Supreme Court, U.S.
FILED
AUG 5 1963
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

October Term, 1963

No. 255

BROS INCORPORATED,

Petitioner

vs.

BROWNING MANUFACTURING COMPANY and SHOVEL SUPPLY CO., INC.,

Respondents

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE EIGHTH CIRCUIT

WARLEY L. PARROTT
1304 Wachovia Bank Building
Charlotte 2, North Carolina
Attorney for Respondents

Of Counsel:
PARROTT & RANKIN
WILTON RANKIN

INDEX

	Page
OPINIONS IN THIS CASE	1
OPINIONS IN RELATED CASES	2
STATUTES INVOLVED	2
COUNTERSTATEMENT OF THE CASE	2
Proceedings In The District Court	2
Proceedings In The Eighth Circuit	3
Proceedings In Related Cases	4
PETITIONER'S QUESTIONS	5
SUMMARY OF REASONS FOR DENYING CERTIORARI	6
ARGUMENT FOR DENYING CERTIORARI	7
No True Conflict Is Presented	7
Decision Is In Accord With The Plain Meaning Of 35 U.S.C. 102(b)	10
No Conflict In Statutory Interpretation	11
No Conflict In Claim Construction	11
Established Case Law Followed	12
Petitioner's Attempt To Contort 35 U.S.C. 102(b)	12
Petitioner's Attempt To Upset Fact Findings	13
Invalidating Effect Of References Describing Device Not Yet Successfully Tested Is Settled Law	14
No Important Legal Issues Presented	15
CONCLUSION	15
CERTIFICATE OF SERVICE	16

CASES CITED

	Page
Aeronautical Communications Equipment, Inc. v. *Pierce*, 371 U.S. 954, 83 S. Ct. 505, 9 L. Ed. 2d 502, 31 U.S.L. Week 3219, 136 USPQ 679 (1963)	8
American Communications Co., Inc. v. *Pierce*, 208 F. 2d 763 (1st Cir. 1953), cert. denied 347 U.S. 944 (1954)	8
Application of Pappas, 214 F. 2d 172, 177 (CCPA 1954)	12
Armour Research Foundation v. *C. K. Williams & Co.*, 280 F. 2d 499, 501, 503 (7th Cir. 1960)	14
Bros Incorporated v. *Browning Manufacturing Company, et al*, 317 F. 2d 413, 137 USPQ 624 (8th Cir. 1963)	1, 11
Bros Incorporated v. *W. E. Grace Mfg. Co.*, 158 F. Supp. 786 (N.D. Tex. 1958), 261 F. 2d 428 (5th Cir. 1958)	2, 4
Bros Incorporated v. *W. E. Grace Mfg. Co.*, __F. 2d__, 138 USPQ 357 (5th Cir. 1963)	2, 4, 10
Browning Mfg. Co. et al v. *Bros Incorporated*, 134 USPQ 231 (D. Minn. 1962)	1
Collins v. *Owen*, 310 F. 2d 884, 887 (8th Cir. 1962)	12, 14
Gibson-Stewart Co. v. *Wm. Bros Boiler & Mfg. Co.*, 116 USPQ 138 (N.D. Ohio 1957), 264 F. 2d 776 (6th Cir. 1959), cert. denied 360 U. S. 929 (1959)	2, 4, 7, 11
Goodyear Tire & Rubber Co., Inc. v. *Ray-O-Vac Co.*, 321 U.S. 275, 278, 64 S. Ct. 593, 88 L. Ed. 721 (1944)	13

Page

Maibohm v. *RCA Victor Co.*,
89 F. 2d 317, 319-320 (4th Cir. 1937) 12, 14

Midland Flour Milling Co. v. *Bobbitt*,
70 F. 2d 416, 418 (8th Cir. 1934) 12

Pierce v. *Aeronautical Communications Equipment, Inc.*, 307 F. 2d 790 (5th Cir. 1962), cert. denied 371 U.S. 954 (1963) 8

Pierce v. *Allen B. DuMont Laboratories, Inc.*, 297 F. 2d 323 (3rd Cir. 1961), cert. denied 371 U.S. 814 (1962) 9

Pierce v. *American Communications Company, Inc.*, 280 F. 2d 278 (1st Cir. 1960), cert. denied 364 U.S. 902 (1960) 8, 9

Pierce v. *Hewlett-Packard Co.*, 220 F. 2d 531 (1st Cir. 1955), cert. denied 350 U.S. 833 (1955) 8

Pickering v. *McCullough*, 104 U.S. 310, 319, 26 L. Ed. 749 (1881) 14

Smith v. *Hall*, 301 U.S. 216, 218, 57 S. Ct. 711, 81 L. Ed. 1049, USPQ 249 (1937) 8

United States v. *Yellow Cab Co.*, 338 U.S. 338, 341-342, 70 S. Ct. 177, 94 L. Ed. 150 (1949) 13

Wisconsin Electric Co. v. *Dumore Co.*, 282 U.S. 813, 51 S. Ct. 214, 75 L. Ed. 728, 8 USPQ 73 (1931) 8

STATUTES AND RULES CITED

	Page
35 U.S.C. 101	2
35 U.S.C. 102	11, 13
35 U.S.C. 102(a)	5, 12
35 U.S.C. 102(b)	2, 3, 5, 6, 7, 10, 11, 12, 13, 14, 15
35 U.S.C. 102(c)-(g)	5
35 U.S.C. 103	2, 3, 11, 12, 13
Former 35 U.S.C. 31 (R.S. 4886)	2, 12
F.R. Civ. P. 52(a)	6, 13
F.R. Civ. P. 60(b)	6

IN THE

Supreme Court of the United States

October Term, 1963

No. 255

BROS INCORPORATED,

Petitioner

vs.

BROWNING MANUFACTURING COMPANY and SHOVEL SUPPLY CO., INC.,

Respondents

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE EIGHTH CIRCUIT

Respondents pray that this Court deny the Petition for a Writ of Certiorari.

OPINIONS IN THIS CASE

The decisions of the lower courts holding the patent invalid appear at 134 USPQ 231 (D. Minn. 1962), 317 F. 2d 413, 137 USPQ 624 (8th Cir. 1963); and at R. 21-34 and pp. A-1-A-9 Appendix to Petition for Certiorari, respectively.

OPINIONS IN RELATED CASES

The decisions of the Sixth Circuit courts holding the patent valid appear at 116 USPQ 138 (N.D. Ohio 1957), 264 F. 2d 776 (6th Cir. 1959), cert. denied 360 U.S. 929 (1959).

The decisions of the Fifth Circuit courts holding the patent valid appear at 158 F. Supp. 786 (N.D. Tex. 1958), 261 F. 2d 428 (5th Cir. 1958).

The decision of the Court of Appeals for the Fifth Circuit, granting leave to its trial court to reopen and determine what equitable relief should be afforded to the alleged infringers because of the prior publication which was not before that Court when it sustained the validity of the patent, appears as *Bros Incorporated v. W. E. Grace Mfg. Co.*, __F. 2d__, 138 USPQ 357 (5th Cir. 1963).

STATUTES INVOLVED

35 U.S.C. 102(b), reprinted at p. A-20 of Appendix to Petition for Certiorari, is the statute upon which the patent was held invalid.

35 U.S.C. 101, 103, and former 35 U.S.C. 31, appearing at pp. A-19-A-21 of Appendix to Petition for Certiorari, are discussed by the parties in their briefs.

COUNTERSTATEMENT OF THE CASE

Proceedings In The District Court

The trial court held the patent invalid (R. 53) after finding (R. 50-51) that the invention was disclosed in Petitioner's own publication, "50 Ton Compactor With Oscillating Wheels" (R. 161-164) more than one year

prior to filing patent application, as prohibited by 35 U.S.C. 102(b).

Prior to making this finding, the trial court heard expert testimony regarding what the publication disclosed to a person with skill in the art (R. 73, 83-103, 141, and S.R. 1-3, 5, 9-10, 17-18), and also considered that the patentee had referred to this same publication as a "catalog disclosure of the invention" during Patent Office prosecution (R. 29-30, 139-141, 186, 194).

The trial court denied (R. 52) Petitioner's motion for amended findings and conclusions (R. 44-49), which proposed findings alleged that certain of the claim elements are not disclosed in the publication.

Proceedings In The Eighth Circuit

The Court of Appeals for the Eighth Circuit examined and accepted the findings and conclusions of the district court, and concluded that the findings were supported by substantial evidence.

The Eighth Circuit also considered Petitioner's argument that 35 U.S.C. 103 requires that a publication under 35 U.S.C. 102(b) must identically disclose every element of a patent claim to be an invalidating reference. Petitioner's contention was rejected by the Eighth Circuit because of the "plain, obvious and rational meaning" of 35 U.S.C. 102(b), and also because the legislative history of the 1952 Patent Act refutes the contention that 35 U.S.C. 103 was intended to modify or affect in any way 35 U.S.C. 102(b), citing cases prior to and subsequent to the 1952 Patent Act which hold that a prior publication need only describe the invention sufficiently to enable one with skill in the art to carry the invention into practical use.

Proceedings In Related Cases

The courts of the Fifth[1] and Sixth[2] Circuits had no knowledge of the invalidating publication (R. 161-164) at the time they held the patent valid.

Following those decisions, the alleged infringers in the Fifth and Sixth Circuit cases attempted to have those cases reopened for a consideration of the newly discovered evidence of Petitioner's publication (R. 161-164). Petitioner successfully avoided reopening by submitting affidavits to the effect that its publication had not been published until **long after** the critical date asserted by the alleged infringers, and on the further grounds that the alleged infringers had made no proper showing of why the newly discovered evidence had not been presented earlier. Accordingly, the Sixth Circuit denied reopening "in view of the availability of the claimed material in earlier proceedings" (R. 199-202).

For a complete discussion of the motions to reopen before the Fifth and Sixth Circuits, see *Bros Incorporated* v. *W. E. Grace Mfg. Co.*, ___F. 2d___, 138 USPQ 357 (5th Cir. 1963), in which that court recently directed its trial court to consider what equitable relief should be granted to those alleged infringers because of the invalidating prior publication. With respect to Petitioner defending those motions on the grounds that the publication was not distributed at the 1948 Road Show, the Court stated: "In the light of subsequent developments, a court might well conclude that there was a **positive misrepresentation** of the true facts."[3] (Emphasis added.)

---

[1]158 F. Supp. 786, 261 F. 2d 428 (5th Cir. 1958).

[2]116 USPQ 138, 264 F. 2d 776 (6th Cir. 1959).

[3]138 USPQ 357, 362 (5th Cir. 1963).

PETITIONER'S QUESTIONS

Petitioner's six questions contain implications not supported by the fact findings, and in most instances are contorted and misleading.

1. Petitioner's Question 1 implies that the courts "disregarded" the limitations in the patent claims, which is incorrect.

2. With respect to Question 2, the courts below did not in any way **modify** 35 U.S.C. 102(b) in passing on its plain meaning.

3. Question 3 is fairly stated, but should be answered "No" for the reasons given hereinafter.

4. Question 4 is vaguely stated. It was not found that the patent satisfies all conditions set forth in 35 U.S.C. 102(a) and (c)-(g); it was only found that there was no abandonment. The courts did not find that the invention is "not identically disclosed or described" in Petitioner's publication.

5. Petitioner's Question 5 is misleading with respect to the feature of alleged non-reduction to practice, because the court made no finding of **when** the alleged invention was reduced to practice.

6. Question 6 asks this Court to try the case **de novo**.

These questions are discussed in further detail below.

SUMMARY OF REASONS FOR DENYING CERTIORARI

1. The asserted conflict between the decision below and the decisions of the Fifth and Sixth Circuits arises from differences in states of **fact**, and not in the application of a principle of law. Inasmuch as the publication on which the Eighth Circuit courts invalidated the patent was not before the courts of the Fifth and Sixth Circuits at the time they held the patent valid, the decisions in those circuits were based on different facts and accordingly there is no conflict.

2. Subsequent to the Eighth Circuit decision, the Fifth Circuit held that its district court shall hold a hearing under F.R. Civ. P. 60(b) to determine what equitable relief the alleged infringers shall have from the operation of its prior judgment.

3. The decisions below do not conflict with the plain wording of 35 U.S.C. 102(b).

4. The Eighth Circuit did not interpret 35 U.S.C. 102(b) and 103 inconsistently with the Sixth Circuit.

5. There is no difference between the opinions of the courts below and the Sixth Circuit in construing the patent claims, as the trial court below cited the Sixth Circuit opinion and agreed with it (R. 23-25).

6. The Eighth Circuit followed established case law tests in determining that the disclosure in the publication was sufficient to invalidate the patent.

7. Many of the Questions Presented by Petitioner imply "facts" that have not been found.

8. In essence, Petitioner asks this court to disregard F.R. Civ. P. 52(a) and set aside the trial court's finding

of fact that the prior publication discloses the invention, which finding was amply supported by the evidence.

9. The question of whether a reference must describe a device which has been constructed and successfully tested has already been settled, and 35 U.S.C. 102(b) makes no such requirement.

10. The question of law presented by Petitioner is an attempt to contort the meaning of 35 U.S.C. 102(b), which attempted construction was considered by the Eighth Circuit and decided against the Petitioner because of the plain meaning of the statute, the legislative history of the statute, and accepted case law tests for determining the adequacy of description in a prior publication.

11. No valid issues of public importance are presented by Petitioner, and the only real issue is one of money damages between the parties.

12. This court has previously denied[1] a petition for certiorari in a case involving the same patent here in suit, although the questions presented differ from those here presented.

ARGUMENT FOR DENYING CERTIORARI

No True Conflict Is Presented

Although the courts below held the patent invalid and the courts of the Fifth and Sixth Circuits had previously held the same patent valid, there is no true conflict between these decisions for the following reasons.

The courts below held the patent invalid under 35 U.S.C. 102(b) because the alleged invention was described in Petitioner's publication (R. 161-164), which Petitioner

[1] 360 U.S. 929 (1959)

distributed more than one year prior to filing its patent application (R. 53). **This publication was not before the courts of the Fifth or Sixth Circuits when they held the patent valid.** Thus, the Fifth and Sixth Circuit decisions stand upon an entirely different foundation from the decisions below.

As in *Wisconsin Electric Co.* v. *Dumore Co.*, 282 U.S. 813 (1931), "the asserted conflict in decisions arises from differences in states of fact, and not in the application of a principle of law," and the petition for certiorari should be denied.

In *Smith* v. *Hall*, 301 U.S. 216, 218 (1937), this Court affirmed a Second Circuit decision holding the patent invalid because of a prior use defense that had not been "presented or considered" when this Court had earlier sustained the validity of the same patent in a suit involving different parties.

Furthermore, it is clear that granting certiorari is not warranted just by reason of the fact that two different circuit courts have reached different results as to the validity of the same patent. See *Aeronautical Communications Equipment, Inc.* v. *Pierce*, 371 U.S. 954 (1963), denying certiorari. In that case, the Fifth Circuit[1] had held Pat. Nos. 2,133,642 and 2,133,646 **valid**, and certiorari was denied, although the First Circuit had held Pat. No. 2,133,642 **invalid** on three occasions[2]; the Third Circuit

---

[1] *Pierce* v. *Aeronautical Communications Equipment, Inc.*, 307 F. 2d 790 (5th Cir. 1962).

[2] *American Communications Co., Inc.* v. *Pierce*, 208 F. 2d 763 (1st Cir. 1953), cert. denied 347 U.S. 944 (1954); *Pierce* v. *Hewlett-Packard Co.*, 220 F. 2d 531 (1st Cir. 1955), cert. denied 350 U.S. 833 (1955); *Pierce* v. *American Communications Company, Inc.*, 280 F. 2d 278 (1st Cir. 1960), cert. denied 364 U.S. 902 (1960).

had held Patent No. 2,133,642 **invalid**[1]; the First Circuit had held Pat. No. 2,133,646 **invalid**[2]; the Petitioner sought certiorari on the grounds of conflict[3]; and Respondent admitted[4] the conflict.

It cannot be said that the refusal of the Sixth Circuit to reopen (R. 199-202), following the denial of certiorari, amounts to a holding by the Sixth Circuit that Petitioner's publication (R. 161-164) does not disclose the invention. The Sixth Circuit did not discuss the merits or demerits of the publication. Motions to reopen following judgment are always addressed to the discretion of the court, and the requirements for reopening, such as why the newly discovered evidence was not earlier presented, are entirely different from a court considering a defense that has been properly raised at trial. Furthermore, Petitioner forgets to mention to this Court that it defended those motions on the grounds that the publication had not been distributed at the time asserted by those alleged infringers. See the recent

---

[1]*Pierce* v. *Allen B. DuMont Laboratories, Inc.*, 297 F. 2d 323 (3rd Cir. 1961), cert. denied 371 U.S. 814 (1962).

[2]*Pierce* v. *American Communications Company, Inc.*, 280 F. 2d 278 (1st Cir. 1960), cert. denied 364 U.S. 902 (1960).

[3]See p. 5, Petition for Certiorari, filed Oct. 24, 1962, in *Aeronautical Communications Equipment, Inc.* v. *Pierce*, October Term, 1962, No. 558.

[4]See pp. 2-3, Respondent's Brief In Part Support of the Petition, filed Nov. 5, 1962, in *Aeronautical Communications Equipment, Inc.* v. *Pierce*, October Term, 1962, No. 558.

Fifth Circuit decision[1] for a discussion of Petitioner's use of doubtful affidavits in defending against those motions.

The decisions below take cognizance of the earlier refusals of the Fifth and Sixth Circuits to reopen, and adequately distinguish these refusals.

Moreover, the Fifth Circuit[1] pointed out that the trial court in the present case had "correctly" attributed little, if any, weight to the refusals of the Fifth and Sixth Circuits to reopen.

Accordingly, no conflict exists, as the courts below are the only ones which have passed upon the merits of Petitioner's invalidating publication.

Decision Is In Accord With The Plain Meaning Of 35 U.S.C. 102(b)

The pertinent portion of 35 U.S.C. 102(b) reads:

"A person shall be entitled to a patent unless —

(b) the invention was . . . described in a printed publication in this or a foreign country . . . more than one year prior to the date of the application for patent in the United States . . . ."

That statute does not say "identically disclosed or described", but simply prevents the invention from being described in a printed publication, leaving to the courts the task of finding in each individual case what constitutes a sufficient description.

In interpreting 35 U.S.C. 102(b) according to its plain meaning in the present case, the Eighth Circuit stated:

---

[1] *Bros Incorporated* v. *W. E. Grace Manufacturing Company*, ___ F. 2d ___, 138 USPQ 857 (5th Cir. 1963).

"As this Court, not infrequently in the past has said:

'***[T]he plain, obvious and rational meaning of a statute is always to be preferred to any curious, narrow, hidden sense that nothing but the exigency of a hard case and the ingenuity and study of an acute and powerful intellect would discover.'" (p. A-8 Appendix to Petition).

No Conflict In Statutory Interpretation

Petitioner alleges that the Eighth Circuit interpreted 35 U.S.C. 102 and 103 in direct conflict with the conclusion reached by the Sixth Circuit.

An examination of the Sixth Circuit case[1] will show that court passed only on the question of obviousness (35 U.S.C. 103), not mentioning 35 U.S.C. 102(b) or printed publications.

Conversely, the Eighth Circuit[2] affirmed the holding of invalidity under 35 U.S.C. 102(b). 35 U.S.C. 103 and its legislative history were considered by the Eighth Circuit only in refuting the Petitioner's contention that 35 U.S.C. 103 modifies and affects 35 U.S.C. 102(b).

No Conflict In Claim Construction

No differences exist between the courts of the Sixth and Eighth Circuits in construing the patent claims.

The Sixth Circuit concluded, on the basis of the art before it, that the claims were not to obvious subject mat-

---

[1]*Gibson-Stewart Co. v. Wm. Bros Boiler & Mfg. Co.*, 116 USPQ 138 (N.D. Ohio 1957), 264 F. 2d 776 (6th Cir. 1959), cert. denied 360 U.S. 929 (1959).

[2]*Bros Incorporated v. Browning Manufacturing Co. et al*, 317 F. 2d 413, 137 USPQ 624 (8th Cir. 1963).

ter. The district court below quoted from the Sixth Circuit decision and agreed with it (R. 24), and stated that were it not for the defense of prior publication it would be without misgivings as to the validity of the patent (R. 25).

Established Case Law Followed

The Eighth Circuit followed established case law tests for the sufficiency of disclosure required of a prior publication for it to invalidate a patent, citing *Collins* v. *Owen*, 310 F. 2d 884, 887 (8th Cir. 1962), and *Midland Flour Milling Co.* v. *Bobbitt*, 70 F. 2d 416, 418 (8th Cir. 1934).

See also *Maibohm* v. *RCA Victor Co.*, 89 F. 2d 317, 319-320 (4th Cir. 1937), and cases therein cited on the same point.

See also *Application of Pappas*, 214 F. 2d 172, 177 (CCPA 1954) to the effect that an invalidating publication need only "disclose the same inventive concept" as the patent.

Whether these courts were deciding their cases under 35 U.S.C. 102(a), (b) or the pertinent portions of earlier statutes from which 102(a) and (b) were derived, such as former 35 U.S.C. 31 (R.S. 4886), is of no consequence, as the law regarding sufficiency of a description in a prior publication is unchanged.

Petitioner's Attempt To Contort 35 USC 102(b)

Petitioner attempts to present a question of law in contending that 35 U.S.C. 102(b) is modified by 35 U.S.C. 103, to require that every element and functional statement of a patent claim must be "identically disclosed or described" in the prior publication to defeat the patent under 35 U.S.C. 102(b).

This is a strained and unwarranted construction of 35 U.S.C. 102(b), and an attempt to contort the meaning of that statute, which Respondents answer as follows:

1. Prior and subsequent to the 1952 Patent Act, the case law has been to the effect that an invalidating publication need only teach a person skilled in the art to carry out the invention to a practical extent.

2. The plain language of 35 U.S.C. 102(b) makes no requirement with respect to "identically disclosed or described", and it must be assumed that if Congress wished to engraft such a limitation upon the statute, it would have used these words in the statute.

3. The legislative history of 35 U.S.C. 102 and 103, as given in the Eighth Circuit decision, makes it clear that Congress had no legislative intent to change the prior case law requirements with respect to disclosure in a printed publication.

Petitioner's Attempt to Upset Fact Findings

F.R. Civ. P. 52(a) provides that ". . . findings of fact shall not be set aside unless **clearly erroneous** . . . ." (Emphasis added.) This Court follows the "clearly erroneous" requirement, *United States* v. *Yellow Cab Co.*, 338 U.S. 338, 341-342 (1949).

Also, this Court has the additional requirement that it must be a **strong** case for it to set aside findings when made by a district court, and examined and accepted by a court of appeals, *Goodyear Tire & Rubber Co., Inc.* v. *Ray-O-Vac Co.*, 321 U.S. 275, 278 (1944).

The trial court found as a fact that Petitioner's pamphlet discloses the invention to one skilled in the art (R. 50-51) and concluded as law (R. 53) that the patent is

invalid. The Eighth Circuit affirmed, and concluded that there was "a substantial evidentiary basis" for the trial court's finding.

Whether a publication describes an invention is a proper fact finding and invalidity is a conclusion of law. *Maibohm* v. *RCA Victor Co.*, 89 F. 2d 317, 320 (4th Cir. 1937); *Armour Research Foundation* v. *C. K. Williams & Co.*, 280 F. 2d 499, 501, 503 (7th Cir. 1960); *Collins* v. *Owen*, 310 F. 2d 884, 887 (8th Cir. 1962); and decision of the Eighth Circuit herein.

Not only did the trial court find that the publication disclosed the invention (R. 50-51), but the trial court expressly denied (R. 52) Petitioner's motion for amended findings and conclusions which alleged that certain elements of the claims are not disclosed by the publication (R. 44-49).

Accordingly, there is no basis in the findings below for Petitioner to assert that the alleged invention is not described by the publication, identically or otherwise.

Invalidating Effect Of References Describing Device Not Yet Successfully Tested Is Settled Law

Petitioner questions whether a reference describing an invention may be relied upon to invalidate a patent, if the device described by the reference has not yet been successfully tested.

This question was answered against Petitioner in *Pickering* v. *McCullough*, 104 U.S. 310, 319 (1881) and *Collins* v. *Owen*, 310 F. 2d 884, 887 (8th Cir. 1962).

Moreover, the portion of 35 U.S.C. 102(b) dealing with publications does not require that the described invention shall have been built or tested.

No Important Legal Issues Presented

It is respectfully submitted that this court customarily exercises its discretion to grant certiorari in cases which present legal issues of public importance, and the present case does not come within such practice. The legal issue which Petitioner attempts to present is a strained construction of 35 U.S.C. 102(b) which has already been considered and rejected by the Eighth Circuit.

CONCLUSION

In view of the foregoing, Respondents request that the Petition For A Writ Of Certiorari be denied.

Respectfully submitted.

WARLEY L. PARROTT
1304 Wachovia Bank Building
Charlotte 2, North Carolina
Attorney for Respondents

Of Counsel:
PARROTT & RANKIN
WILTON RANKIN

CERTIFICATE OF SERVICE

Three copies of the foregoing Respondents' Brief In Opposition To Petition For A Writ Of Certiorari have been served on Petitioner by mailing said copies first class airmail, postage prepaid, to Petitioner's attorney, Mr. Andrew E. Carlsen, 417 Plymouth Building, Minneapolis 2, Minnesota, this second day of August, 1963.

WARLEY L. PARROTT
1304 Wachovia Bank Building
Charlotte 2, North Carolina
Attorney for Respondents

LIBRARY
SUPREME COURT, U. S.

Office-Supreme Court, U.S.
FILED
AUG 19 1963
JOHN F. DAVIS, CLERK

In the Supreme Court of the United States

OCTOBER TERM 1963

No. 255

BROS INCORPORATED

Petitioner

vs.

BROWNING MANUFACTURING COMPANY AND SHOVEL SUPPLY CO., INC.

Respondents

PETITIONER'S BRIEF IN REPLY TO RESPONDENTS' BRIEF OPPOSING PETITION FOR WRIT OF CERTIORARI

ANDREW E. CARLSEN
417 Plymouth Building
Minneapolis 2, Minnesota
Attorney for Petitioner

Of Counsel:
DOUGLAS L. CARLSEN

Hayward-Court Brief Ptg. Co., Mpls. 15, Minn.

In the
Supreme Court of the United States

OCTOBER TERM 1963

No. 255

BROS INCORPORATED

Petitioner

vs.

BROWNING MANUFACTURING COMPANY AND SHOVEL SUPPLY CO., INC.

Respondents

PETITIONER'S BRIEF IN REPLY TO RESPONDENTS' BRIEF OPPOSING PETITION FOR WRIT OF CERTIORARI

Respondents' brief appears to emphasize rather than minimize the necessity for Supreme Court rulings on the questions presented in the Petition now before the Court. The importance of the issues is now further accentuated by the decision of the Fifth Circuit Court of Appeals in the related case of *Bros Incorporated v. W. E. Grace Manufacturing Company, et al.*, referred to on pages 4 and 10 of the present Petition. As that decision (as yet reported only in 138 USPQ 357) was not received until after the present Petition was prepared and filed, and has received but cursory consideration in respondents' brief, a few further observations appear necessary.

In the Fifth Circuit case both the Grace Motion in the

District Court as well as the Grace Notice of Appeal specifically requested a new trial on the sole basis of one that would be—

> "devoted to the issue of statutory invalidity of the (Bros) patent in suit by reason of prior description in a printed (Bros) publication, contrary to the conditions prescribed by 35 U.S.C. 102(b)."

No other issue is involved, and that is the precise issue here presented.

In granting the new trial the Fifth Circuit Court of Appeals makes it specifically and abundantly clear by its Footnote 25, and, as in its closing paragraph, that—

> "It is far too early to foretell whether, on the merits, the Texas District Court or this Court would or would not agree with the Minnesota Court, or now, the 8th Circuit."

The Fifth Circuit decision also points out (Part VIII) that this

> "is not—the more routine case in which validity or invalidity turns on intricate evidentiary questions of prior art, anticipation, lack of invention, novelty, or the like"

and recognizes that

> "The public interest in a governmentally bestowed monopoly is of trascendent importance."

Thus, and as matters now stand, the Bros patent in suit is valid in the Sixth Circuit, invalid in the Eighth Circuit, and of undetermined status in the Fifth as well as all other circuits. To add to the confusion thus generated it may be noted, as pointed out in the Fifth Circuit decision, (Part VIII) as—

"of unique significance here for the papers show that the Minnesota plaintiffs are Texas concerns, and another infringement suit brought by the Patentee remains untried in San Antonio (Texas)."

In short, and if the Fifth Circuit eventually concludes that there is no "basic statutory infirmity" in the Bros patent, then the two Texas plaintiffs (present respondents) will escape liability for infringement while all other infringers in all circuits except the Eighth may well be obliged to respect the patent, unless, of course, the present Petition is granted and this Court passes on the issues that have been squarely raised by the Petition.

Under such circumstances the most impelling reasons exist to justify the intervention of this Court, not only for resolving the conflict between the Sixth and Eighth Circuit conclusions with respect to validity, but to guide the Fifth Circuit as well as other courts on critical questions of substantive patent law that are here and apparently for the first time brought to the attention of this Court.

Practically all of respondents' objections to the Petition have already been fully met in the petitioner's initial presentation. Other criticisms are of a collateral, trivial and sometimes misleading nature which the Court will, we submit, have no difficulty in summarily disposing of without further authorities or argument in rebuttal.

The Petition should be granted.

Respectfully submitted,

ANDREW E. CARLSEN
Attorney for Petitioner

CERTIFICATE OF SERVICE

Three copies of the foregoing Petitioner's Brief in Reply to Respondents' Brief Opposing Petition for Writ of Certiorari have been served on the respondents by mailing said copies first class air mail, postage prepaid, to respondents' attorneys, Messrs. Parrott & Rankin, Wachovia Bank Building, Charlotte 2, North Carolina, this 16th day of August, 1963.

ANDREW E. CARLSEN
417 Plymouth Building
Minneapolis 2, Minnesota
Attorney for Petitioner

Of Counsel:
DOUGLAS L. CARLSEN